

Attorney Docket No.: DEX-0287
Inventors: Salceda et al.
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REMARKS

Claims 1-17 are pending in the instant application. Claims 10-13 and 16 have been withdrawn from consideration by the Examiner. Claims 1-9, 14, 15 and 17 have been rejected. Claims 1, 14 and 15 have been amended. Support for these amendments is provided in the specification at page 14, line 1, through page 16, line 30, page 33, lines 8-14 and page 40, line 26 through page 44, line 20. No matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Restriction Requirement

The requirement for Restriction mailed July 26, 2004 has been vacated and the following Restriction Requirement has been made:

Group I, claims 1-9, 14/1, 15/1 and 17, drawn to nucleic acids, nucleic acid molecule hybridization assays, vectors, host cells, methods of producing polypeptides, and nucleic acid vaccines, classified in class 536, subclass 23.1, class 435, subclasses 6, 320.1, 325, 69.1, and class 514, subclass 44;

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Group II, claims 10, 11, 14/11, and 15/11, drawn to polypeptides, and polypeptide vaccines, classified class 530, subclass 350 and class 514, subclass 12; and

Group III, claims 12, 13 and 16, drawn to antibodies, antibody assays, and methods of treatment using antibodies, classified in class 530, subclass 387.1 class 435, subclass 7.1, and class 424, subclass 130.1.

The Examiner suggests that the nucleic acids, vectors, host cells and nucleic acid vaccines of Group I are materially different from, and therefore independent and distinct from the polypeptides and polypeptide vaccines of Group II and the antibodies of Group III. Further, the Examiner suggests that the methods of Group I may be practiced independently of the methods of Group III.

The Examiner also suggests that Applicant is required to select no more than one of the individual sequences for examination.

Applicants respectfully traverse this Restriction Requirement.

MPEP §803 provides two criteria which must be met for a restriction requirement to be proper. The first is that the inventions be independent or distinct. The second is that there would be a serious burden on the Examiner if the

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restriction is not required. A search of prior art relating to an elected nucleic acid would also reveal any references teaching polypeptides and antibodies related thereto.

Accordingly, Applicants believe that searching of all the claims, at least when limited to elected nucleic acids or polypeptides, is overlapping and would not place an undue burden on the Examiner if the Restriction is not made.

Thus, since this Restriction Requirement does not meet both criteria as set forth in MPEP § 803 to be proper, reconsideration and withdrawal of this Restriction Requirement is respectfully requested.

In addition, with respect to the election of a single sequence, MPEP § 803.04 clearly states that a reasonable number of nucleotide sequences, normally ten sequences, can be claimed in a single application. Accordingly, reconsideration to include a more reasonable number of at least 10 sequences in accordance with MPEP § 803.04 is also respectfully requested.

However, in an earnest effort to be completely responsive, Applicants elect Group I, claims 1-9, 14/1, 15/1 and 17 and SEQ ID NO:105 encoding SEQ ID NO:238 with traverse.

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**II. Rejection of Claims 1-9, 14, 15 and 17 under 35 U.S.C.
112, second paragraph**

Claims 1-9, 14, 15 and 17 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner suggests that claim 1 is vague and indefinite because it claims more than was elected. Further, the Examiner suggests that recitation of "comprising a nucleic acid sequence" in claim 1(a) and 1(b) and "encodes an amino acid sequence" in claim 1(a) are vague and indefinite because it is not clear whether applicant intends these phrases to include the entire sequence of SEQ ID NO:105 or SEQ ID NO:238 or to include all nucleic acids or amino acids that may include "a" sequence as short as two contiguous nucleotides of SEQ ID NO:105 or two contiguous amino acids of SEQ ID NO:238. The Examiner suggests that recitation of selectively hybridizes and will selectively hybridize in claim 1 are also vague and indefinite because selective hybridization depends upon the presence of competing binding partners in the reaction mixture and there is no mention of competing binding partners in the claims. In addition, the Examiner suggests that recitation of "means

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for determining the presence of the nucleic acid molecule of claim 1" in claim 15 is vague and indefinite

Accordingly, in an earnest effort to advance the prosecution of this case, but without conceding in any way to the Examiner's remarks with respect to this rejection, Applicants have amended claim 1 to be commensurate with the elected subject matter and to delete the phrases suggested to be vague.

Further, without conceding to the Examiner's remarks regarding definiteness of claim 15, Applicants have amended this claim in accordance with teachings at page 40, line 26 through page 44, line 20 to state that the kit comprises a nucleic acid molecule which hybridizes under stringent conditions to a nucleic acid molecule of claim 1.

Withdrawal of this rejection under 35 U.S.C. 112, second paragraph is therefore respectfully requested.

III. Rejection of Claims 1-3, 7 and 8 under 35 U.S.C.

102 (b)

Claims 1-3, 7 and 8 have been rejected under 35 U.S.C. 102(b) as being anticipated by Puttikhunt et al. (Molec. Gen. Genet. 247:118 (1995)). The Examiner suggests that Puttikhunt et al. discloses a DNA that encodes amino acids

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51-60 of SEQ ID NO:238 and that the DNA of Puttikhunt et al. is embraced by the claims, in particular claim 1(a).

Applicants respectfully traverse this rejection.

Applicants respectfully disagree with the Examiner that disclosure of a 9 amino acid peptide by Puttikhunt anticipates the instant claimed nucleic acid sequence encoding the 212 amino acid, SEQ ID NO:238.

As discussed in Section II, supra, Applicants have amended claim 1 to address the Examiner's suggestion that a lack of clarity in claim language made it unclear whether applicant intended the claim to include the entire sequence of SEQ ID NO:238 or to include all amino acids that may include "a" sequence as short as two contiguous amino acids of SEQ ID NO:238. Applicants believe this amendment also renders moot the instant rejection over Puttikhunt et al.

Withdrawal of this rejection is therefore respectfully requested.

IV. Rejection of Claims 1-5, 7-9, 15 and 17 under 35 U.S.C. 102(b)

Claims 1-5, 7-9, 15 and 17 have been rejected under 35 U.S.C. 102(b) as being anticipated by Williams et al. (WO 99/38972). The Examiner suggests that Williams et al.

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discloses a lung cancer marker DNA of 300 nucleotides length that matches with 300 nucleotides of SEQ ID NO:105.

Applicants respectfully traverse this rejection.

As discussed in Section II, supra, Applicants have amended claim 1 to address the Examiner's suggestion that a lack of clarity in claim language made it unclear whether applicant intended the claim to include the entire sequence of SEQ ID NO:105 or to include all nucleic acids that may include "a" sequence as short as two contiguous nucleic acids of SEQ ID NO:105. Further Applicants have amended claim 1 in accordance with teachings at page 14-16 and page 33 to state in part (c) a nucleic acid molecule that hybridizes under stringent conditions to the nucleic acid molecule of (a) or (b). Applicants believe this amendment also renders moot the instant rejection over the 300 nucleotide sequence taught by Williams et al.

Withdrawal of this rejection is therefore respectfully requested.

V. Rejection of Claims 1-3, 7 and 8 under 35 U.S.C. 102(a)

Claims 1-3, 7 and 8 have been rejected under 35 U.S.C. 102(a) as being anticipated by GenBank Accession No. AL592304. The Examiner suggests that GenBank Accession No.

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ALAL592304 discloses a DNA that is 60.5% identical to SEQ ID NO:105.

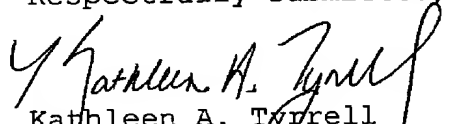
Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claim 1 in accordance with teachings at page 14, lines 1-8 to state a nucleic acid molecule having at least 70% sequence identity to the nucleic acid molecule of (a) or (b).

Withdrawal of this rejection under 35 U.S.C. 102(a) is therefore respectfully requested.

VI. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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